

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

SEP 25 2003

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JAMES T. BACHMANN

Appeal No. 2001-2634  
Application No. 09/033,901<sup>1</sup>

ON BRIEF

Before JERRY SMITH, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-9. At page 2 of the Brief, Appellant has indicated that the final rejection of only claims 3-9 is appealed, which is the only rejection before us on appeal.

We reverse.

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<sup>1</sup> Application for patent filed February 28, 1998.

BACKGROUND

Appellant's invention relates to a method for showing the execution trail of objects in a graphical programming language by highlighting the objects that have executed.

Representative independent claims 1<sup>2</sup> and 4 and dependent claim 3 are reproduced as follows:

1. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:

executing a plurality of the icons;

setting a flag for each icon executed in the executing step, the flag corresponding with the each icon; and

highlighting each icon corresponding with each flag set in the setting step.

3. The method of claim 1, further comprising the steps of:

receiving an input subsequent to the executing step;  
and

performing the highlighting step in response to the receiving step.

4. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:

executing a plurality of the icons;

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<sup>2</sup> Although the rejection of claim 1 is not before us, its text is included since claim 1 is the base claim of the appealed dependent claim 3.

Appeal No. 2001-2634  
Application No. 09/033,901

indicating which of the icons are executed in the  
executing step;

determining, subsequent to the executing step and based  
on the indicating step, that the plurality of icons have  
been executed; and

highlighting the plurality of executed icons in  
response to the determining step.

The prior art references of record relied upon by the  
Examiner in rejecting the appealed claims are:

Wilson et al. (Wilson)	5,392,207	Feb. 21, 1995
Kurtenbach	5,867,163	Feb. 2, 1999 (filed Oct. 6, 1997)

Claims 3-9 stand rejected under 35 U.S.C. § 103(a) as being  
unpatentable over Wilson in view of Kurtenbach.

We make reference to the answer (Paper No. 14, mailed  
November 30, 2000) for the Examiner's reasoning, and to the brief  
(Paper No. 13, filed September 18, 2000)<sup>3</sup> and the reply brief  
(Paper No. 15, filed February 6, 2001) for Appellant's arguments  
thereagainst.

#### OPINION

The Examiner relies on Wilson for disclosing an iconic  
programming system wherein a plurality of icons are executed and  
highlighted on a display (answer, page 3). Indicating that

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<sup>3</sup> Appellant filed the brief as an amended brief subsequent to an  
earlier filed brief (Paper No. 12, filed August 14, 2000).

Appeal No. 2001-2634  
Application No. 09/033,901

Wilson does not specifically teach the steps of setting a flag for the executed icon and highlighting that icon, the Examiner further relies on Kurtenbach and concludes that "to make internal use of flags in such a programming system" would have been obvious because the executed icons can be thus differentiated (answer, pages 3 & 4). The Examiner further asserts that including an input subsequent to the executing step and performing the highlighting step in response to the receiving step would also have been obvious to one of ordinary skill in the art (answer, page 4).

Appellant argues that while Wilson highlights programming icons, the highlighting is in response to and during execution of the icon and not in response to an input and subsequent to execution of the icon (brief, page 6). Appellant further asserts that Kurtenbach also highlights the icon to provide feedback related to the command that is currently being executed (id.). Additionally, Appellant argues claims 3 and 4 require that the highlighting be performed in response to the determining step and either subsequent to the executing step or in response to the receiving step, whereas the applied prior art references teach that the icon presently executing should be highlighted (brief, pages 6-8).

In response to Appellant's arguments, the Examiner asserts that Figure 4 of Wilson provides for the process of execution of the icons where an input signal must be sent to the system to instruct the highlighting of the icon (answer, page 5). However, the Examiner relies on the teachings of Kurtenbach that appear, in most parts, to be similar to those of Wilson and concludes that it would have been obvious to commence the execution of the icon prior to the highlighting process (id.).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references."

In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Turning to Wilson, we find ourselves in general agreement with the interpretations outlined by both the Examiner (answer, page 3) and Appellants (brief, pages 5 & 6) and further find that the reference provides for the programming icons corresponding to "TRACE," "BREAKPOINT" and "SINGLE STEP," as three debugging commands, whose instructions that are currently being executed are highlighted (col. 9, lines 58-66). In "TRACE" mode, Wilson highlights the icon that corresponds with a particular instruction that is being executed (col. 10, lines 55-58). Wilson further provides for the "BREAKPOINT" option in which a processor holds a certain breakpoint address and highlights the icon as the address of the instruction currently being executed is equal to that breakpoint address (col. 12, lines 32-36). Finally, in the "SINGLE STEP" option, Wilson loops through the process blocks and highlights the icon as soon as a given new block identification is encountered (col. 13, lines 32-35). Therefore, in all of these options, the highlighting of the icon is performed during the execution of the icon and not subsequent to the executing step in response to a signal indicating that the icon is executed.

Kurtenbach also merely provides for highlighting of the icons as the commands are executed in order to provide some visual feedback to the user concerning which command is currently being executed (abstract; col. 7, lines 35-38). The highlighting of the icons in Kurtenbach is performed by placing a dark band around the icon that is being executed (col. 7, lines 35-41).

Thus, as pointed out by Appellant (reply brief, page 4), neither reference teaches or suggests that a previously executed icon should be highlighted "in response" to the reception of an input signal. We also agree with Appellant that even if a signal may be generated to indicate that a second icon should be highlighted, the combination of the references provides no suggestion that the first icon or another previously executed icon is also highlighted in response to this signal (id.). In that regard, both Wilson and Kurtenbach merely highlight the icon while that icon is currently being executed and not in response to a flag or in response to a receiving step or a determining step indicating that the icon has been executed.

Therefore, assuming, arguendo, that it would have been obvious to combine Wilson and Kurtenbach, as held by the Examiner, there would not have been any teaching or suggestion that any input signal would have been necessarily sent to the

Appeal No. 2001-2634  
Application No. 09/033,901

system subsequent to the executing step or, in response to a determining step, as recited in claims 3-9. In fact, the Examiner's proposed combination of the references is based on the speculation that the highlighting process is performed only "subsequent to" or after the actual execution of the icon, whereas both Wilson and Kurtenbach, as discussed above, explicitly teach that an icon is highlighted as the icon is currently being executed. Accordingly, since the Examiner has failed to establish a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 3-9 cannot be sustained.



Appeal No. 2001-2634  
Application No. 09/033,901

## CONCLUSION

In view of the foregoing, the decision of the Examiner to reject claims 3-9 under 35 U.S.C. § 103 is reversed.

REVERSED

*Jerry Smith*  
JERRY SMITH

JERRY SMITH  
Administrative Patent Judge

HOWARD B. BLANKENHORN

HOWARD B. BLANKENSHIP  
Administrative Patent Judge

Mahshid D. Saadat

MAHSHID D. SAADAT  
Administrative Patent Judge

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Appeal No. 2001-2634  
Application No. 09/033,901

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P.O. Box 7599  
M/S DL429  
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Application Serial Number 09/033 901

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Docket Personnel I

OB/Heard Classification

Outline case

Reviewers

Review/assign panel

Prepare order/remand

Docket Personnel I

Enter data in ACTS/PALM

Prep case (if panel assigned)

Docket Personnel I

Mail remand/order

Administrators

Assign Hearing Date

Docket Personnel II

Mail Notice of Hrg

Enter Hrg data in ACTS/PALM

Legal Technician

Typed decision

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DESIGNATION OF PANEL

Pursuant to (1) the Commissioner's authority to designate the members of the Board of Patent Appeals and Interferences to hear cases before the Board (35 U.S.C. 7(b)), and (2) Commissioner Lehman's memorandum dated May 1, 1994 (delegating to the Chief Administrative Patent Judge the responsibility of designating members to hear cases before the Board), it is ORDERED that the panel of the Board of Patent Appeals and Interferences designated to hear this case shall consist of the following members of the Board:

☒ On Brief    ☐ Heard    ☐ Redesignation    ☐ Expanded Panel,  
see addendum.

1. Judge Saadat

2. Judge Blankenship

3. Judge Terry Smith

Bruce H Stoner Jr  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

Date of Hearing: \_\_\_\_\_